

REMARKS

The present amendment is being filed together with a Request for Continued Examination (RCE). In view of the RCE, Applicant respectfully requests entry of the present amendment and any amendments previously filed but not entered.

Upon entry of the amendment submitted January 24, 2005, and the amendment presented above, claims 69-75, 82, 83, and 100-108 will be pending in the application. Claims 94 and 96-99 are canceled by the amendment submitted January 24, 2005, and claims 84-93, 95, and 109-119 are canceled by the above amendment. The specification is amended to correct typographical errors and to add a reference to a patent that issued from a related application. The attached printout from PAIR, the website of the U.S. Patent and Trademark Office, provides evidence that the error in the priority claim is typographical. The printout reports that the current application (U.S.S.N. 10/021,368) and U.S.S.N. 09/605,175 both claim the benefit of U.S.S.N. 09/201,038, which is properly cited in the priority claim. No new matter has been added by the amendments.

For the record, and in reference to #2 on form PTOL-303, the Advisory Action dated March 11, 2005 (herein, "the Advisory Action"), it is incorrect that Applicant's reply to the final Office action was filed after the date of filing a Notice of Appeal. Applicant filed a response to the final Office action on January 24, 2005, and subsequently filed a Notice of Appeal on February 22, 2005. The Notice of Appeal was received by the U.S. Patent and Trademark Office on February 24, 2005, and the present amendment and RCE are being filed within the time limit set by the Notice of Appeal.

Obviousness-type Double Patenting

In the comments attached to the Advisory Action, the Examiner states (at page 2):

Claims 69-75, and 82-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 10-14 of U.S. Patent No. 6,152,387 (387') for the reasons set forth in the prior Office action, mailed December 19, 2003 ...

Upon entry of the after-final amendment filed January 27, 2005, claims 69-75, 82-95 and 100-119 will remain rejected.

In response, Applicant notes that claims 84-95 are canceled by the amendment submitted January 24, 2005, and the amendment presented above. Further, Applicant submits herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) and 37 C.F.R. §3.73(b) to overcome the rejection of claims 69-75, 82, and 83. Accordingly, this ground for rejection should now be withdrawn.

35 U.S.C. § 112, ¶ 1

Written Description: In the comments attached to the Advisory Action, the Examiner states (at pages 2-3; emphasis added):

Claim (*sic.*) 69-75, 82-95 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed December 19, 2003.

Upon entry of the after-final amendment, this rejection will be mooted.

With the filing of the RCE, the after-final amendment should now be entered and should, as the Examiner stated, render moot the rejection of claims 69-75, 82, and 83. By way of the present amendment, claims 84-95 have been canceled. Thus, the rejection based on an alleged lack of an adequate written description should be withdrawn.

The claims that have been canceled or otherwise amended were canceled or amended solely in the interest of obtaining a Notice of Allowance. Applicant's actions are not an admission that the canceled subject matter is not patentable, and Applicant expressly reserves the right to pursue claims to the original subject matter, or to any subject matter supported by the present specification, without prejudice.

Enablement: In the comments attached to the Advisory Action, the Examiner states (page 3):

Claim (*sic.*) 69-75, and 82-95 are rejected under 35 U.S.C. 112, first paragraph, for lack of enablement for the reasons set forth in the prior Office action mailed December 19, 2003.

Upon entry of the amendment, claims 69-75, 82, 83, and 100-108 overcome this rejection, whereas claims 84-95 and 109-119 will be rejected.

The claims that “will be rejected”, claims 84-95 and 109-119, have been canceled by the present amendment. Thus, this ground for rejection is now moot and should be withdrawn.

35 U.S.C. § 112, ¶ 2

Claims 84-95 were rejected as being indefinite. In the Advisory Action, however, the Examiner states, “[u]pon entry of the amendment filed January 27, 2005, this rejection will be obviated” (Advisory Action at page 3).

With the filing of the RCE, the after-final amendment should now be entered and should, as the Examiner stated, obviate the rejection of claims 84-95, which are canceled by the present amendment. Thus, the rejection based on lack of clarity should now be withdrawn.

Applicant : Vimla Band
Serial No. : 10/021,368
Filed : December 12, 2001
Page : 10 of 10

Attorney's Docket No.: 00398-100005

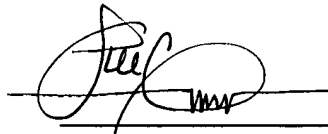
CONCLUSION

In view of the submission of the Terminal Disclaimer and the amendments that should now be entered, Applicant contends the present claims are now in condition for allowance, which action is respectfully requested.

A \$65 check for the Terminal Disclaimer fee required under 37 C.F.R. §1.20(d); a \$510 check for a 3-month petition for extension of time; and a \$395 check for the RCE fee required under 37 C.F.R. §1.114 are enclosed. Any other necessary charges or credits can be applied to Deposit Account No. 06-1050, with reference to Attorney Docket No. 00398-100005.

Respectfully submitted,

Date: August 22, 2005



Lee Crews, Ph.D.
Reg. No. 43,567

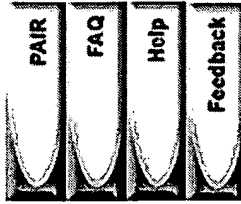
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906



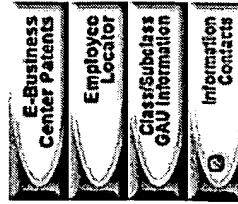
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Search results for application number:09/201,038			
Application Number:	09/201,038	Customer Number:	-
Filing or 371(c) Date:	11-30-1998	Status:	Patented Case
Application Type:	Utility	Status Date:	11-09-2000
Examiner Name:	NASHED, NASHAAT T	Location:	FILE REPOSITORY (FRANCONIA)
Group Art Unit:	1652	Location Date:	04-26-2005
Confirmation Number:	1057	Earliest Publication No:	-
Attorney Docket Number:	00398/100003	Earliest Publication Date:	-
Class/ Sub-Class:	435/006	Patent Number:	6,153,387
First Named Inventor:	VIMLA BAND, NATICK, MA (US)	Issue Date of Patent:	11-28-2000
Title Of Invention: NES-1 POLYPEPTIDES, DNA, AND RELATED MOLECULES AND METHODS			

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Parent Continuity Data		
Description	Parent Number	Parent Filing or 371(c) Date
		Parent Status

This application is a Continuation of	08/628,198	04-05-1996	Patented
Which is a Division of	08/467,155	06-06-1995	Patented
Child Continuity Data			
09/605,175 filed on 06-28-2000 which is Abandoned claims the benefit of 09/201,038			
10/021,368 filed on 12-12-2001 which is Pending claims the benefit of 09/201,038			

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